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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,170	12/01/2003	Steven M. Schein	ST-027 Cont	2063
75563	7590	12/09/2008		
ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER IDOWU, OLUGBENGA O	
			ART UNIT 2425	PAPER NUMBER
			MAIL DATE 12/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,170	<b>Applicant(s)</b> SCHEIN ET AL.	
	<b>Examiner</b> OLUGBENGA O. IDOWU	<b>Art Unit</b> 2425	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1 - 20 have been considered but are moot in view of the new ground(s) of rejection.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 -14 of U.S. Patent No. 6 732 369

B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant and copending applications discuss the same concept of searching for and tagging programs that are relevant to user.

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For example, note the following relationship between the instant application claims and co-pending applications claims:

Claims 1 and 8 of the instant application corresponds to claims 1, 2, 9, 10, 17 and 18 of the copending application.

Claims 2 and 9 of the instant application corresponds to claim 3, 11 and 19 of the copending application

Claims 3 and 10 of the instant application corresponds to claim 4, 12 and 20 of the copending application

Claims 4 and 11 of the instant application corresponds to claim 5 and 13 of the copending application

Claims 5 and 12 of the instant application corresponds to claim 6 and 14 of the copending application

Claim 6 and 13 of the instant application corresponds to claim 7 and 15 of the copending application

Claim 7 and 14 of the instant application corresponds to claim 8 and 16 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim s 1 – 4, 9 – 12 and 17 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, patent number: 5 798 785 in view of Alten, patent number: 5 781 246.

As per claims 1, 9 and 17, Hendricks teaches an interactive electronic program guide (IPG) including a display screen comprising:

a database local to a viewer for storing television schedule information including information about television programs and a plurality of criteria associated with each television program (database on STB storing abstracts, col. 30, lines 40 – 50, lines 10 - 13); and

a microprocessor local to the viewer(microprocessor, col. 9, line 66) configured to automatically generate a set of favorite criteria about television programs that the viewer would likely be interested in (the STB understanding the user and creating a profile, col. 29, lines 26 - 37), search the database for identifying a television program that includes at least one of the favorite criteria (searching the database, col. 30, lines 43 - 44), tag the identified television program stored in the local database that includes the at least one of the favorite criteria (selecting programs, col. 30, lines 47 - 49), and activate a

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function of the IPG related to the tagged television program without viewer's intervention (displaying a list of suggested programs to viewer, col. 30, lines 48 - 50).

Hendricks does not teach activating a function of the IPG related to the tagged television program without viewer's intervention.

In an analogous art, Alten teaches activating a function of the IPG related to the tagged television program without viewer's intervention (displaying a reminder with program information, col. 14, lines 44 - 57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hendricks' program suggestion system by including a system that displays data to user without user intervention, as described in Alten's guide schedule system, for the advantage of providing the user with alternatives and making the system more flexible.

As per claims 2, 10 and 18, the combination of Hendricks and Alten teach further comprising a display controller for automatically displaying on the display screen a portion of the schedule information including the identified television program in guide format (displaying a list of suggested programs to viewer, col. 30, lines 48 - 50).

As per claims 3, 11 and 19, the combination of Hendricks and Alten teach wherein the favorite criteria includes one or more of actor's name (actor, col. 30, line 55), director's name, type of program, other broadcast times, other broadcast sources, and program theme.

As per claims 4, 12 and 20, the combination of Hendricks and Alten teach wherein the microprocessor is configured to monitor and store the viewer's selections of television programs, and heuristically learn the viewer's favorite criteria according to the viewer's selections of television programs (the STB understanding the user and creating a profile, col. 29, lines 26 - 37).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 6, 8, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, patent number: 5 798 785 in view of Alten, patent number: 5 781 246, in further view of Levine, patent number: 5 692 214.

As per claim 5 - 6 and 13 - 14, the combination of Hendricks and Alten teach a system that selects and presents programs that a user might like.

The combination does not teach a system where the tagged program is automatically tuned to.

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In an analogous art, Levine teaches wherein the activated function is automatically programming a recording device to record the tagged television program at scheduled telecast time (automatic recording, col. 4, lines 18 – 31, 40 - 45).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combination of Hendricks and Alten by including an automatic recording system as described in Levine for the advantages of unattended recording, and compensating for changes in recording schedule.

As per claims 8 and 16, the combination of Hendricks and Alten teach a system that selects and presents programs that a user might like.

The combination does not teach a system that downloads the tagged program.

In an analogous art, Levine teaches wherein the activated function is automatically downloading a copy of the tagged television program to a digital storage medium at scheduled telecast time (Levine: automatic recording, col. 4, lines 18 – 31, 40 – 45, Hendricks: digital signals, col. 6, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combination of Hendricks and Alten by including an automatic recording system as described in Levine for the advantages of unattended recording, and compensating for changes in recording schedule.



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8. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, patent number: 5 798 785 in view of Hashimoto, patent number: 5 179 439.

As per claims 7 and 15, the combination of Hendricks and Alten teach a system that selects and presents programs that a user might like.

The combination does not teach a system that automatically reminds the viewer of a tagged program.

In an analogous art, Hashimoto teaches wherein the activated function is automatically reminding the viewer to view the tagged television program (alert, col. 6 lines 19 - 26).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combination of Hendricks and Alten by including a reminder system as described in Levine for the advantages of watching the program live or watching and recording the program.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUGBENGA O. IDOWU whose telephone number is (571)270-1450. The examiner can normally be reached on Monday to Friday, 7am - 5pm Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendelton can be reached on 571 272 7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olugbenga O Idowu/  
Examiner, Art Unit 2425

/Brian T. Pendleton/  
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